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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,003	12/27/2004	Shinji Naruse	2004_2036A	7588
513 7590 11/21/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER ALEJANDRO, RAYMOND				
ART UNIT		PAPER NUMBER		
1795				
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11/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,003

Applicant(s)

NARUSE, SHINJI

Examiner

Raymond Alejandro

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/08 has been entered.

This paper is in reply to the amendment accompanying the aforementioned RCE. The 35 USC 112 rejection and all of the previously stated grounds of rejection under Section 103 have been overcome by the applicant. Refer to the abovementioned amendment for more details regarding applicant's rebuttal arguments and remarks. As a result, all currently pending claims are newly rejected over newly discovered art as proffered *infra* on the written record:

Election/Restrictions

1. Applicant's election of Group I and Species 1a, 2 and 2c (claims 12 and 15: the specific species paper, silicon compound and silica gel, respectively) in the reply filed on 05/07/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 13-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 05/07/08 and the office action dated 07/14/08.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al 5076864.

The present application is to a separator wherein the disclosed inventive concept comprises a coating material on a separating feature.

As to claims 12 and 15:

Tanaka et al disclose a multilayer printed wiring board (*the electrical/electronic part*) (Abstract/COL 1, lines 5-10 and 20-23/COL 3, lines 37-40) wherein the materials which can be used for laminating the internal layer boards include reinforcing material or a base material such as silica and/or aramid fabric (COL 3, lines 10-25). Tanaka et al expressly disclose that mixtures thereof (*←emphasis supplied*) can be employed therein (COL 3, lines 21-22). *Thus, Tanaka et al at once envisage combining both materials in an electrical/electronic part to form a separating feature therein.*

1st Examiner's note: as to the method limitation "subject to heat treatment before and/or after coated", it is noted that a method limitation incorporated into a product claim does not patentable distinguish the product because what is given patentably consideration is the product itself and not the manner in which the product was made. Therefore, the patentability of a product is independent of how it was made. As a result, the process steps of a product-by-process claim do not impart any significant property or structure to the claimed end product. And, if there is any difference, the difference would have been minor and obvious. Determination of patentability of a product-by-process claim is based on the scope of the product itself.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."
In re Thorpe 777 F.2d 695, 698, 227 USPQ 964,966 (Fed Cir. 1985) and MPEP 2113.

2nd Examiner's note: the specific "sucking height" (or electrolyte retention) is deemed to be an inherent property or characteristic of the separator which is associated to the construction material thereof and its coating. For instance, applicant states that "The separator of this invention which has been coated in the aforementioned manner has good electrolyte retention owing to coating". "The electrolyte retention of the coated separator of this invention as shown by the above-mentioned formula (1) [equation 1 $\rightarrow h2\eta/\gamma$] is 0.7 mm or more" (See applicant's specification at page 5, lines 3-21). Thus, having been made both separators (applicant's separator and the prior art separator) of the same construction material, then, it can be fairly argued that the separator of the prior art must have the same properties.

Accordingly, products of identical chemical composition can not have mutually exclusive properties, and thus, the claimed property (i.e. the specific “sucking height” or electrolyte retention), is necessarily present in the prior art material.

“Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

See MPEP 2112.01 [R-3] Composition, Product, and Apparatus Claims

Thus, the present claims are anticipated.

5. Claims 12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Curcio et al 2002/0179334.

As to claims 12 and 15:

Curcio et al disclose an interconnect between layers of a multilayer circuit board or printed wiring board or chip carrier material (*the electrical/electronic part*) (Abstract/P0002-0004, 0029) wherein the first layer 12A therefor includes a reinforced material such as silica and additionally the first layer 12A may include polyamide films having an adhesive layer on either side such as an aramid paper (P0029). *Thus, Curcio et al at once envisage combining both materials in an electrical/electronic part to form a separating feature therein.*

1st Examiner’s note: *as to the method limitation “subject to heat treatment before and/or after coated”, it is noted that a method limitation incorporated into a product claim does not patentable distinguish the product because what is given patentably consideration is the product*

itself and not the manner in which the product was made. Therefore, the patentability of a product is independent of how it was made. As a result, the process steps of a product-by-process claim do not impart any significant property or structure to the claimed end product. And, if there is any difference, the difference would have been minor and obvious. Determination of patentability of a product-by-process claim is based on the scope of the product itself.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."
In re Thorpe 777 F.2d 695, 698, 227 USPQ 964,966 (Fed Cir. 1985) and MPEP 2113.

2nd Examiner's note: *the specific "sucking height" (or electrolyte retention) is deemed to be an inherent property or characteristic of the separator which is associated to the construction material thereof and its coating. For instance, applicant states that "The separator of this invention which has been coated in the aforementioned manner has good electrolyte retention owing to coating". "The electrolyte retention of the coated separator of this invention as shown by the above-mentioned formula (1) [equation 1 $\rightarrow h^2 \eta / \gamma t$] is 0.7 mm or more" (See applicant's specification at page 5, lines 3-21). Thus, having been made both separators (applicant's separator and the prior art separator) of the same construction material, then, it can be fairly argued that the separator of the prior art must have the same properties.*

Accordingly, products of identical chemical composition can not have mutually exclusive properties, and thus, the claimed property (i.e. the specific "sucking height" or electrolyte retention), is necessarily present in the prior art material.

"Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior

art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

See MPEP 2112.01 [R-3] Composition, Product, and Apparatus Claims

Thus, the present claims are anticipated.

6. Claims 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese publication JP 2000-125499 (hereinafter referred to as the JP'499).

As to claims 12 and 15:

The JP'499 divulges a fixing member of a coil exhibiting conductivity (*the electrical-electronic part*) (Abstract) consisting of a laminated sheet comprising an aramid fiber paper 18 which a reinforcing layer and a high thermal conductivity silicon-based sheet 19 forming a fixing member for separation or interconnection (Abstract). *Thus, the JP'499 at once envisages combining both materials including a silicon-based material in an electrical/electronic part to form a separating feature therein.*

1st Examiner's note: as to the method limitation "subject to heat treatment before and/or after coated", it is noted that a method limitation incorporated into a product claim does not patentable distinguish the product because what is given patentably consideration is the product itself and not the manner in which the product was made. Therefore, the patentability of a product is independent of how it was made. As a result, the process steps of a product-by-process claim do not impart any significant property or structure to the claimed end product. And, if there is any difference, the difference would have been minor and obvious. Determination of patentability of a product-by-process claim is based on the scope of the product itself.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

In re Thorpe 777 F.2d 695, 698, 227 USPQ 964,966 (Fed Cir. 1985) and MPEP 2113.

2nd Examiner's note: the specific "sucking height" (or electrolyte retention) is deemed to be an inherent property or characteristic of the separator which is associated to the construction material thereof and its coating. For instance, applicant states that "The separator of this invention which has been coated in the aforementioned manner has good electrolyte retention owing to coating". "The electrolyte retention of the coated separator of this invention as shown by the above-mentioned formula (1) [equation 1 $\rightarrow h_2 \eta / \gamma t$] is 0.7 mm or more" (See applicant's specification at page 5, lines 3-21). Thus, having been made both separators (applicant's separator and the prior art separator) of the same construction material, then, it can be fairly argued that the separator of the prior art must have the same properties.

Accordingly, products of identical chemical composition can not have mutually exclusive properties, and thus, the claimed property (i.e. the specific "sucking height" or electrolyte retention), is necessarily present in the prior art material.

"Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

See MPEP 2112.01 [R-3] Composition, Product, and Apparatus Claims

Thus, the present claims are anticipated.

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7. Claims 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Butman Jr et al 4473765.

As to claims 12 and 15:

The disclosure of Butman Jr et al makes known a part of an electrical machine (*the electrical/electronic part*) (Abstract/Col 1, lines 6-10/CLAIM 1) including in combination a layer of an aramid paper used to separate a silicon-based compound therein (Abstract/COL 2, lines 52-63/COL 5, lines 10-15 & CLAIMS 1). *Thus, Butman Jr et al at once envisage combining both materials including a silicon-based material in an electrical/electronic part to form a separating feature therein.*

1st Examiner's note: as to the method limitation "subject to heat treatment before and/or after coated", it is noted that a method limitation incorporated into a product claim does not patentably distinguish the product because what is given patentable consideration is the product itself and not the manner in which the product was made. Therefore, the patentability of a product is independent of how it was made. As a result, the process steps of a product-by-process claim do not impart any significant property or structure to the claimed end product. And, if there is any difference, the difference would have been minor and obvious. Determination of patentability of a product-by-process claim is based on the scope of the product itself.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."
In re Thorpe 777 F.2d 695, 698, 227 USPQ 964,966 (Fed Cir. 1985) and MPEP 2113.

2nd Examiner's note: the specific "sucking height" (or electrolyte retention) is deemed to be an inherent property or characteristic of the separator which is associated to the construction

material thereof and its coating. For instance, applicant states that "The separator of this invention which has been coated in the aforementioned manner has good electrolyte retention owing to coating". "The electrolyte retention of the coated separator of this invention as shown by the above-mentioned formula (1) [equation 1 $\rightarrow h^2 \eta / \gamma t$] is 0.7 mm or more" (See applicant's specification at page 5, lines 3-21). Thus, having been made both separators (applicant's separator and the prior art separator) of the same construction material, then, it can be fairly argued that the separator of the prior art must have the same properties.

Accordingly, products of identical chemical composition can not have mutually exclusive properties, and thus, the claimed property (i.e. the specific "sucking height" or electrolyte retention), is necessarily present in the prior art material.

"Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

See MPEP 2112.01 [R-3] Composition, Product, and Apparatus Claims

Thus, the present claims are anticipated.

Response to Arguments

8. Applicant's arguments with respect to claims 12 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (571) 272-1282. The examiner can normally be reached on Monday-Thursday (8:00 am - 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raymond Alejandro/
Primary Examiner, Art Unit 1795